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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,339	03/26/2004	Raghunath V. Chaudhari	03108/0201076-US0	8252
7278	7590	06/24/2005		EXAMINER
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257				WITHERSPOON, SIKARL A
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/810,339	CHAUDHARI ET AL.	
	Examiner Sikarl A. Witherspoon	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 March 2005.

2a) This action is **FINAL**.                                   2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 and 21-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 and 21-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

The examiner has considered applicants' amendment filed March 28, 2005. The amendment was sufficient to obviate the rejection of record under 35 U.S.C. 102(b); the examiner has subsequently withdrawn the rejection under 35 U.S.C. 103(a) over Borgoanker et al alone; however, the following rejection has been maintained and has been rewritten to include claims newly added by the amendment.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantam et al (US 6,495,726) and further in view of Borgaonkar et al.

The instant claims are drawn to a process for preparing benzaldehyde by the liquid phase oxidation of toluene in an organic solvent, and in the presence of a catalyst system comprising a transition metal(s) and a bromide promoter, and in the presence of diluted oxygen, wherein the oxygen concentration is in the range of 1-10% of the reaction mixture, and then cooling the reaction mixture and separation the product. Further limitations include separating the product by distillation, the transition metal catalyst comprising manganese and iron or manganese and vanadium, the bromide promoter being sodium, hydrogen or zinc bromide, the solvent being an organic acid,

and the selectivity to benzaldehyde being in the range of 60-75%, with benzoic acid and benzyl alcohol obtained as side products.

Kantam et al teach a process for preparing benzaldehyde by the liquid phase oxidation of toluene, by providing a continuous flow of air in the presence of a catalyst selected from iron, cobalt, molybdenum, and nickel, and preferably a co-catalyst selected from manganese and copper salts, a promoter and a bromine source selected from cobalt, zinc, or sodium bromide, and a carboxylic acid solvent selected from acetic, propionic, or benzoic acid, at a temperature ranging from 60 to 130° C and pressures in the range of 1-10 bars. The process also produces benzyl alcohol and benzoic acid. The amount of manganese or copper co-catalyst, with respect to toluene is in the range of 0.004-0.017 mol%, and the amount of bromide source, with respect to toluene is in the range of 0.14-1.14 mol% (col. 4, lines 12-65). Example 2 teaches selectivity to benzaldehyde of 62.77% (col. 6, lines 5-19).

The differences between Kantam et al and the instant invention are that Kantam et al do not teach cooling the reaction mixture prior to separation of the product(s), do not expressly teach separation of the product by distillation, do expressly not teach the catalyst being comprised of a combination of manganese and iron or manganese and vanadium, at the molar ratio of manganese to iron or manganese to vanadium, as claimed herein, do not teach an oxygen concentration of 1-10% in nitrogen, and do not teach a reaction pressure of 20-70 bar.

With regard to cooling the reaction mixture prior to product separation and a reaction pressure of 20-70 bar, Kantam et al do not teach these limitations. However,

Borgaonkar et al teach a process for the liquid phase oxidation of toluene to benzaldehyde by air, in an acetic acid medium, with a cobalt acetate catalyst and sodium bromide as a promoter (abstract). The reaction is conducted at a temperature in the range of 95 to 180° C and a pressure of 1.0 to 21 kg/cm<sup>2</sup> (1 to about 21 bar) [table III, p 456]. The concentration of bromine with respect to toluene is shown in table IV on page 457. *The reaction mixture is allowed to cool to room temperature and then filtered* (p 455 column 2, second paragraph). It therefore would have been obvious to a person of ordinary skill in the art, in view of the combined reference teachings, to conduct the process taught by Kantam et al at a higher pressure (higher than 10 bar), since Borgaonkar et al, teach a similar process for the liquid phase oxidation of toluene at pressure ranges up to 21 bar. One of ordinary skill would have been motivated to modify the pressure so as to obtain such a pressure that would afford an optimal conversion of toluene to benzaldehyde in said liquid phase oxidation.

Likewise, it would have been obvious to a person of ordinary skill to cool the reaction mixture prior to separation of the product, in the process taught by Kantam et al, since Borgaonkar et al, in their similar oxidation process, teach such a cooling, prior to separation of the product. In view of both reference teachings, one of ordinary skill would reasonably conclude that the product, i.e., benzaldehyde, can be separated with or without cooling of the reaction mixture, with no adverse effect on the aldehyde product.

With regard to the means of separating the product, as stated above, Kantam et al do not expressly teach separation by distillation. Borgaonkar et al, on the other hand,

teach separation by filtration (p 455, second column, second paragraph). The examiner, however, purports that the means by which the product is separated is immaterial, absent a showing that a particular type of separation technique would afford unexpected properties, i.e., purity, etc., to the product being separated. Accordingly, the examiner purports that it would have been obvious to a person of ordinary skill in the art, at the time the present invention was made, to employ any known technique for separating products formed via a liquid phase process, including filtration and/or distillation, or solvent extraction.

Although Kantam et al do not expressly teach a catalyst comprising a combination of manganese and iron or manganese and vanadium, the examiner purports that such a combination is rendered obvious, absent a showing of unexpected results, since Kantam et al teaches that such metals as iron cobalt molybdenum, and nickel, and a co-catalyst comprising manganese or copper salts, are employed as catalyst in their process. Therefore such catalyst(s) combinations as that which is recited in the instant claims would have been apparent to a person of ordinary skill in the art. The molar ratio of these metals is not of patentable import, absent a showing of unexpected results, because a person of ordinary skill would employ the minimum ratios that would afford optimal catalytic activity in the liquid phase oxidation taught by the reference. Likewise, the molar ratio of metal with respect to toluene that is recited in the instant claims is found obvious. As suggested by Kantam et al a lower concentration of catalyst and co-catalyst slows down corrosion of the reactor (col. 5, lines 46-51). Therefore, a person of ordinary skill would have been motivated to modify the

concentration of metal catalyst, with respect to toluene, in order to obtain the amount of metal catalyst that would effectively catalyze the oxidation of toluene, and also minimize corrosion of the reactor, so as to obtain optimal results.

With regard to the concentration of oxygen present in the oxidizing agent, as stated above, Kantam et al do not teach the oxygen concentration recited in the instant claims. However, claim 1, the independent claim in the present invention, recites the presence of *diluted* oxygen, i.e., not 100% oxygen. Kantam et al conduct their oxidation process in the presence of air, which is comprised of about 21% oxygen, and nitrogen (about 75%). Applicants have not shown any unexpected benefit afforded by conducting their process in the presence of oxygen at a concentration of 1-10%. Accordingly, the examiner takes the position that it would have been obvious to a person of ordinary skill in the art to modify the oxygen concentration of the oxidizing agent, whether it is air or another oxygen-containing material. A person of ordinary skill would have been motivated to do so by the desire to provide the optimal concentration of oxygen to produce the desired oxidized compound; in the case of Kantam et al, benzaldehyde. Higher concentrations of oxygen may result in higher production of the acid compound, instead of the aldehyde, while lower oxygen concentrations may increase production of the alcohol.

### ***Response to Arguments***

Applicants' arguments filed March 28, 2005 have been fully considered but they are not persuasive. The thrust of applicants' argument is that neither reference relied

upon for the rejection of record teaches or suggests the total concentration of oxygen being in the range of from 1 to 10% of the total reaction mixture, and that selectivity and yield can be increased by so modifying the oxygen concentration. The examiner does not find this argument persuasive, first, because as stated above, Kantam et al conduct their oxidation process in the presence of air, which is comprised of about 21% oxygen, and nitrogen (about 75%). However, applicants state that the oxygen concentration is 1 to 10% of the *entire reaction mixture*, which includes the solvent, bromide promoter, and reactant, i.e., toluene. The examiner purports that when taking into consideration all of the variables that comprise the reaction mixture, the concentration of oxygen becomes somewhat lower. Furthermore, applicants have not shown any unexpected benefit afforded by conducting their process in the presence of oxygen at a concentration of 1-10%. Accordingly, the examiner takes the position that it would have been obvious to a person of ordinary skill in the art to modify the oxygen concentration of the oxidizing agent, whether it is air or another oxygen-containing material. A person of ordinary skill would have been motivated to do so by the desire to provide the optimal concentration of oxygen to produce the desired oxidized compound; in the case of Kantam et al., benzaldehyde. Higher concentrations of oxygen may result in higher production of the acid compound, instead of the aldehyde, while lower oxygen concentrations may increase production of the alcohol. Lastly, applicants claim a selectivity to benzaldehyde of 60 to 75%; example 2 of Kantam et al teaches a selectivity to benzaldehyde of 62.77% (col. 6, lines 5-19), which is within the range claimed by applicants.

Applicants may wish to consider submitting a side-by-side comparison, in declaration form, showing unexpected or superior selectivity to benzaldehyde, by oxidizing toluene according to the instant invention, wherein the only variable is the oxygen concentration.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikarl A. Witherspoon whose telephone number is 571-272-0649. The examiner can normally be reached on M-F 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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